

#BAF/2600



Docket No.: 07791-0092-25X DIV



ATTORNEYS AT LAW

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/472,197

Applicants: Will H. GARDENSWARTZ, et al.

Filing Date: December 27, 1999

For: COMMUNICATING WITH A COMPUTER BASED  
ON THE OFFLINE PURCHASE HISTORY OF A  
PARTICULAR CONSUMER

Group Art Unit: 3621

Examiner: HAYES, John W.

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SIR:

Attached hereto for filing are the following papers:

Reply Brief (In Triplicate)

Request for Oral Hearing

Our check in the amount of \$280.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF:

WILL H. GARDENSWARTZ ET AL. : GROUP ART UNIT: 3621

SERIAL NO: 09/472,197 :

FILED: DECEMBER 27, 1999 : EXAMINER: HAYES, J.

FOR: COMMUNICATING WITH A COMPUTER  
BASED ON THE OFFLINE PURCHASE  
HISTORY OF A PARTICULAR CONSUMER

REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

Appellant herein submits the present Reply Brief in response to points raised in the Examiner's Answer of July 1, 2002.

First Issue

The Examiner has alleged that Claims 85-90 are directed to non-statutory subject matter under 35 U.S.C. § 101. Claim 85 relates to a computer readable medium for storing information for delivering a targeted advertisement comprising a first field for storing a first identifier identifying a first computer associated with the consumer and a second field linked to the first field for storing a second identifier associated with the said first identifier and corresponding to an observed offline purchase history of the consumer. The purchase history includes information of an offline purchase of the consumer collected at a point of sale when the offline purchase transpired. In Claim 87 the first field stores a first identifier corresponding to a first computer and associated with an observed offline purchase history of a consumer. The second field stores a purchase behavior classification based on at least one

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selected purchase behavior criterion and the observed offline purchase history of the consumer. In Claim 89 the first field stores a first identifier corresponding to a targeted message and a purchase behavior classification. The second field stores a personal identification number corresponding to the consumer. In each case the stored data are readable by at least one processor to automatically deliver the targeted advertisement to the consumer.

With respect to the rejection of each independent claim noted above, the Examiner has alleged that the claims do not recite that the data structure is a computer program or instructions executable by a computer system to perform some function but rather that the claims are structured in terms of a data structure *per se* that is embodied on a computer readable medium and do not recite that the data structure is executable by a computer system to perform some function. (See Examiner's Answer, page 7).

Appellants, however, note that the pending independent claims have been amended to recite stored data that causes or directs a computer to perform a functional operation. Specifically, claim 85 now recites that "the information stored in the first and second fields being readable by at least one processor to automatically deliver the targeted advertisement to the first computer," claim 87 recites "the first identifier and the purchase behavior classification being readable by at least one processor to automatically deliver the targeted advertisement to the first computer in response to receiving the first identifier from the first computer," and claim 89 recites "the first identifier and the personal identification number being readable by at least one processor to automatically deliver the targeted message to the consumer in response to receiving the first identifier."

The recitation of causing a processor to automatically deliver a targeted advertisement is clearly statutory subject matter. Indeed it echoes an exemplary example of statutory subject

matter provided by the MPEP. According to § 2106, "a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional relationship among that data and the computing process" and is statutory even if that data represents nonfunctional material. See MPEP § 2106.

Applicants submit that not only do the present independent Claims recite a processor which is caused to function by the stored data but also that the stored data is functional in and of itself. As noted in the amendment filed April 3, 2001, the stored data is computer readable and therefore a functional relationship exists among the data and the processor reading the data. Pages 4-5.

Therefore, Applicants respectfully submit that claims 85-90 fully comply with the requirements of 35 U.S.C. § 101. Thus, the rejection is believed to be overcome.

#### Second Issue

The Examiner has alleged that Claims 85 and 86 are unpatentable over Scroggie et al in view of Laor, Claim 87 is unpatentable over Scroggie et al in view of Jermyn, Claim 88 is unpatentable over Scroggie, Jermyn, and further in view of Laor, and Claims 89 and 90 are obvious over Scroggie et al in view of Csaszar et al. Appellants, however, assert that independent Claims 85, 87 and 89 define over the applied references.

Regarding the rejection of Claim 85, in response to the Final Office Action of November 8, 2001, Appellants noted that the Examiner, must provide a motivation to combine the references. (See Appeal Brief of May 7, 2002, page 5).

In response, the Examiner suggested that Laor provides motivation "by indicating that consumers or computers associated with consumers can be identified through the use of

cookies and indicating that this will enable an information provider such as a vendor to recognize the consumer and provide some predetermined and preprogrammed level of customization at the discretion of the information provider. (See Examiner's Answer page 9).

Appellants, however, note that this allegation is contrary to the teachings of Scroggie et al. As noted by the Examiner, Scroggie et al discloses a database for storing information readable by a processor for facilitating the delivery of a targeted advertisement, comprising a data structure including a field for storing a first identifier corresponding to a first computer associated with a consumer in the form of an e-mail address. (See Examiner's Answer page 3.) The Examiner also noted that Scroggie et al "fails to specifically disclose that the first identifier identifies a specific computer". (Id.)

Appellants agree with this summary of the teachings of Scroggie et al. Appellants, however, assert that since Scroggie et al clearly does not disclose identifying a particular computer, but rather identifies a consumer by an e-mail address, and since Laor teaches the identification of a computer, Laor cannot be combined with Scroggie et al. Since Scroggie et al teaches the identification of a particular e-mail address and e-mail addresses can be inputted from various computers, it would be unreasonable to limit the teachings of Scroggie et al to only one particular computer containing a cookie identifying that particular computer.

For these reasons, Appellants believed that the rejection of Claim 85, and the rejection of Claim 86 which is dependent on Claim 85, is overcome.

Regarding the rejection of Claim 87, Appellants requested that the Examiner provide a motivation for combining the references to Jermyn and Scroggie et al. In response, the Examiner alleged "the motivation would be to provide an advantage and benefit to the

consumer in that they would be presented incentives that they would most likely be interested in."

Appellants however assert that Scroggie et al alone provides the advantage of presenting customers incentives that they would be interested in, and that therefore, the combination of Scroggie et al and Jermyn would be redundant. According to the Scroggie et al specification, the invention may be further enhanced by employing individual purchase incentives of individual customers." (See Scroggie et al, column 12, lines 8-10). The customer is then able to select a purchasing incentive based on some aspect of the customer's prior shipping history. (Id.)

The fact that Jermyn also teaches a technique for customizing purchasing incentives does not mean that one with skill in the art would be motivated to combine Jermyn with Scroggie et al. Rather, there would have to be a showing that the Jermyn technique for customizing purchasing incentives somehow has an advantage over the teachings of Scroggie et al. No such evidence has been provided.

Therefore, Applicants believe that the rejection of Claim 87, and Claim 88 which is dependent upon Claim 87, is overcome.

Regarding the rejection of Claims 89 and 90, Applicants assert that Claims 89 and 90 are allowable for substantially the same reasons as the reasons noted above as to the allowability of Claims 87 and 88. As above, the Examiner has alleged that a motivation to combine the teachings of Csaszar with the teachings of Scroggie et al exists because Csaszar which discloses a database containing attributes of a customer and targeted messages that an interactive voice response system can deliver to a customer based on the consumer attributes, provides motivation by indicating that an advantage of interactive voice response systems is that they can deliver information that consumers desire at any time and at low cost.

However, a reasonable interpretation of Scroggie et al reveals that there is no teaching or suggestion that and Scroggie et al fails to provide the ability to deliver information that consumers desire at any time and at low cost. Indeed, Scroggie et al teaches that the purchase incentives delivered to the customer can be delivered to the consumer through the consumer's e-mail address for example. Appellants respectfully submit that there are few easier and less costly ways to deliver information to anyone, including consumers., than through personal e-mail addresses.

The fact that Csaszar also teaches a technique for delivering information to the consumer does not mean that one with skill in the art would be motivated to combine Csaszar with Scroggie et al. Rather, there would have to be a showing that the Csaszar technique for delivering information to the consumer has an advantage over Scroggie et al. No such evidence has been provided.

Therefore, Applicants believe that the rejection of Claim 89, and Claim 90 which is dependant upon Claim 89, is overcome.

Respectfully submitted,

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